

### REMARKS

The claims are now 10-20. Claims 10 and 16 are amended herein, and claim 20 is added.

Applicants appreciate the examiner's recognition of patentability of the subject matter of claims 12, 14, 16 and 17. It appears that the examiner also intended to include claim 11 in this group as it is not rejected and the composition utilizing this binder is commensurate in scope with applicants' allowed parent application, now US Patent 6,511,784.

### **SUPPORT FOR AMENDMENTS**

Support for newly added claim 20 is found in the specification at page 5, lines 12-24, in particular line 21. (Support need not be *in ipso verbis*. See, e.g., *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). The remaining amendments -- except for the "consists essentially of," which is discussed below -- are but corrections of obvious typographical errors. The § 112, second paragraph rejections, are believed overcome.

### **THE PRIOR ART REJECTION**

All claims were rejected under 35 USC § 103(a) as unpatentable over Notsu et al (EP 0 666 184 A1) (Notsu).

It is first noted that the claims now utilize the language well understood and defined language, "consists essentially of." This language necessarily excludes material which would affect the basic and novel characteristic of the ingredients of the claim *but*

does not exclude other things included in the specification and/or which do not excludes material which would affect the basic and novel characteristic of the composition. In this context see, inter alia, *PPG Industries, Inc. v. Guardian Industries Corp.*, 48 USPQ2d 1359 (Fed.Cir. 1998) and the cases discussed therein.

It should further be noted that Notsu discloses a printing plate precursor wherein the binder "consists essentially of" (in the above noted sense) *nitrocellulose* and polyester as binder, similar to EP-710573 cited in applicants' disclosure (page 3, line 1). Clearly, nitrocellulose with a polyester as the principle binder would materially affect the *basic and novel characteristics* of applicants' plates in which the principle binder is a silicone rubber.

Notsu does not disclose silicone rubbers as binder for laser engravable plates. The binder system of Notsu consists of nitro-cellulose and a second organic binder (Notsu, page 4, line 17 ff). Silicone rubbers are not disclosed as polymeric *binders*. Silicone rubber is disclosed by Notsu only as water repellant, i.e., an auxiliary component. It is used in amounts of 0.1-5%, preferably 0.2-2%, of all components of the photosensitive layer (page 5, lines 28-33).

An analysis of, e.g., Examples 4, 5 and 6 of Notsu (examples cited by the examiner in the rejection), evinces the following:

7.7 parts nitrocellulose

24.6 parts carbon black-containing paste

43.3 parts polyester resin

5.4 parts crosslinker

18.7 parts methyl ethyl ketone

0.2-1 parts water repellant (silicones or other compounds).

The examples clearly demonstrate that the silicones (among the many possible water repellents) used by Notsu function as additives rather than as principle binder as do applicants.

Moreover, as to the thickness of applicants' layer, Notsu actually teach away from applicants thickness in the sense of *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550, 1552 (Fed.Cir. 1994) : "Knapp appears to teach away from the selection of bisphenol A by focusing on more complex phenols ...". Applicants' least thickness of the layer (0.1 mm) is less desirable in Notsu than his "preferable" thickness as well as is "practically" thickness.

It should thus be apparent that the reference does not make out the necessary prima facie case for obviousness. There is no teaching, suggestion or motivation to modify the reference to the extent necessary to come up with applicants' invention. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988) ("Something in the prior art as a whole must suggest the desirability and thus the obviousness, of making the combination.")

#### **CONCLUSION**

For the reasons set forth above, allowance is respectfully solicited.

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paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read "N. G. Torchin", with a horizontal line extending from the end.

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